

CASE ON/4-32312A

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

HOHNEKER ET AL.

APPLICATION NO: 10/501,207

FILED: JULY 9, 2004

FOR: COMBINATIONS COMPRISING EPOTHILONES AND ANTI-METABOLITES

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

INVENTOR'S REFUSAL TO SIGN: STATEMENT OF FACTS

Sir:

Applicants wish to bring to the Examiner's attention the fact that one of the named inventors, John David Rothermel, has refused to sign any documents relating to this patent application. More specifically, Mr. John David Rothermel is refusing to sign the inventorship documents.

A copy of the application papers was sent to the last known address of the nonsigning inventor, Mr. John David Rothermel, on August 12, 2004. The application papers were delivered via Federal Express on August 13, 2004. To date, we have not received the signed documents.

Applicants have made a "diligent effort" to reach the inventor and have spoken to him in regard to the patent applications of which he is an inventor. Mr. John David Rothermel, is no longer employed by Novartis and has said that he has been notified by his attorney not to sign any further documents, including documents in connection with patent applications. Therefore, Mr. John David Rothermel is refusing to sign documents pertaining to this patent application.


Attached is a copy of the Conditions of Employment, which Mr. John David Rothermel signed in August 19, 1970, and states that all invention and improvements made or conceived by Employee, either solely or in collaboration with others, and whether or not

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patented, shall become and remain the property of Company, its successors and assigns unless expressly released by Company. At this time, Novartis has not expressly released this patent application.

Respectfully submitted,

Novartis  
Corporate Intellectual Property  
One Health Plaza, Building 104  
East Hanover, NJ 07936-1080  
(862) 778-7852

  
Oona A. Jackson  
Attorney for Applicants  
Reg. No. 48,152

Date: March 2, 2005



## STANDARDS OF CONDUCT

The objective of this document is to state to all associates the Company's position regarding standards of conduct in business activities, and to have the associate acknowledge his or her understanding of this company policy.

### A. SCOPE

All associates, all locations.

### B. STATEMENT OF POLICY

All of the Company's business activities are to be conducted in a manner consistent with the highest level of business ethics and in complete compliance and respect for the letter and the spirit of all applicable laws. The Company's well-earned reputation in this important area must be protected at all times. No act, however well intentioned, which places this reputation in jeopardy will be condoned.

### C. RESPONSIBILITY

It is the responsibility of each associate to maintain strict adherence to this policy. Any violation of this policy will result in appropriate disciplinary measures, and possible termination of employment. Whenever you need help in understanding your legal obligations, you should consult the General Counsel, the Associate General Counsel, or the Senior Counsel.

### D. GUIDELINES

The following guidelines are not intended to be all-inclusive; the propriety of any activity must be considered in relation to moral, legal, and ethical standards of the highest order.

1. An associate's responsibility to the Company includes a duty, at all times, to act in the best interests of the Company, free from any potential personal or private interests that might reasonably adversely influence his or her judgment. While it is not possible to set forth all types of activities which might give rise to actual or potential conflicts of interest, the following situations are examples of unacceptable conduct.

#### a. Financial Interest

An associate must not have a direct or indirect financial interest in a privately-owned organization, or a direct or indirect substantial financial interest in a publicly-owned outside organization, either of which is a current or potential supplier of goods or services, a customer, or a competitor of the Company, unless the circumstances are fully disclosed in writing to the appropriate PCMC member and written approval by the PCMC member and Vice President of Human Resources has been obtained. A "substantial" interest in a publicly-owned organization means an ownership interest of two percent or greater of the capital stock of such organization.

#### b. Personal Services

An associate may not furnish directive, managerial or consultative services to any outside organization which is a current or potential supplier of goods or services, a customer, or a competitor of the Company, unless the circumstances are fully disclosed in writing to the appropriate PCMC member and written approval by the PCMC member and Vice President of Human Resources has been obtained.

**c. Gifts and Entertainment**

An associate may not accept, directly or indirectly, any loan or gift, gratuity, favor, or entertainment of more than nominal value from outside persons with whom the Company has an existing or a potential relationship as a supplier of goods or services, a customer, or competitor. In any event, an associate who is offered anything with a value of more than \$100 must report such offer to his or her immediate supervisor. Similarly, an associate must not offer business gifts on behalf of the Company if it would violate a law or appear unethical or embarrassing to the Company.

**d. Outside Employment**

An associate may not have any outside employment or interests which encroach on the time or attention which should be devoted to the Company's affairs or otherwise detract from the Associate's ability to perform his or her responsibilities. Any questions concerning outside employment should be reviewed with the associate's supervisor.

**2. Confidential Information**

Using confidential information for personal profit or advantage, or disclosing confidential information to unauthorized persons (including Company associates as well as non-associates), is strictly prohibited.

The use by an associate of business information concerning a contemplated acquisition to purchase or sell stock in the target company, or the disclosure to a third party of such a contemplated acquisition, are examples of such prohibited conduct.

Federal securities laws prohibit the purchase or sale of securities about which you have material confidential information. Furthermore, you are not allowed to provide such information to another person who then makes a purchase or sale. If you become aware that the Company is considering a transaction with another firm, you must keep that information to yourself. Examples of these transactions include acquisitions, licenses, co-marketing agreements, etc. Use of inside information for personal benefit, either directly or indirectly, is a serious violation of the law and may be subject to criminal prosecution.

**3. Use of Company Property**

All associates have duty to protect and conserve Company property entrusted to them. An associate shall not directly or indirectly use, or allow the use of Company property of any kind (including property leased to the Company), for other than Company activities, except with the authorization of his or her supervisor or other appropriate individual.

**4. Relations with Government Agencies**

The Company is engaged in the research, development, manufacture and distribution of products which are subject to regulation by various governmental agencies at the federal, state and local levels. The conduct of all associates whose duties bring them in contact with such agencies must be above reproach.

No associate shall give or offer any payment or other item of value to any government associate. Occasional luncheons would not conflict with this principle.

**5. Political Contributions**

Company political contributions are prohibited from any source to any candidate for national office or to any political party. Individual Sandoz associates, however, are permitted to make political contributions from their personal funds through SEPAC, which is the political action committee sponsored by Sandoz.

**6. Agents and Consultants**

Any arrangement for the retention of a sales agent, business consultant, or professional shall be in accordance with Company procedures and upon the assurance that no part of any payment is to be used for purposes other than that specified.

**7. Unrecorded Funds or Assets**

No undisclosed or unrecorded fund or asset shall be established for any purpose.

**8. Financial or Other Books and Records**

Associates who are responsible for the completeness and correctness of financial and other books and records relating to their operations are required to enter all assets, liabilities, payments and other disbursements in such books in accordance with generally accepted accounting principles, as well as with the established practices and policies of the Company, and in a manner which will reflect the nature and purpose as well as the amount thereof. In this connection, there shall be no by-passing of established internal control procedures, and no false or artificial entries shall be made in the books and records for any reason, and no associate shall participate in any procedures that result in such prohibited act.

**E. APPEARANCE OF IMPROPRIETY**

At some time in the future you may be presented with a situation not covered by these guidelines but which could, in your judgement, give the appearance of being unethical, unfair, compromising of the Company's reputation, or wrong. If you are unsure whether a conflict may exist, or whether your action may be inconsistent with the spirit of the guidelines, discuss the situation with your supervisor, department head or the General Counsel, the Associate General Counsel, or the Senior Counsel.

**F. THE COMPANY'S RESPONSIBILITIES**

Compliance with the law and the rules of society is a foundation of the Sandoz culture. We are all responsible for preserving this foundation.

It is the Company's policy to fully support all aspects of these Standards of Conduct.

If you come forward in good faith to call a possible violation of our guidelines to the attention of management, you will not be subject to any form of reprisal. At the same time, if you know of a violation but fail to report it, you may be subject to disciplinary action.

If you identify a possible impropriety, the Company will investigate and, if appropriate, advise you of the results.

**G. Procedure**

Each present associate and each new associate will receive a copy of this policy and agree in writing to abide by it. Additionally, certain associates will acknowledge in writing, on an annual basis, his or her compliance with this policy.

## SANDOZ-WANDER, INC.

## CONDITIONS OF EMPLOYMENT

This is an agreement between SANDOZ-WANDER, INC. and/or all subsidiary companies and divisions herein called "COMPANY" and John Rottman herein called "EMPLOYEE."

1. EMPLOYEE, in consideration of his employment by COMPANY, and other good and valuable consideration specified herein, agrees:
  - (a) That he will, during the period of his employment and thereafter, hold in strictest confidence, and not disclose to any person, firm, or corporation, without the express authorization of an officer of COMPANY, any information, manufacturing technique, process, formula, development or experimental work, work in process, business, trade secret, or any other secret or confidential matter relating to the products, sales, or business of COMPANY or its affiliates or subsidiaries except as such disclosure or use may be required in connection with EMPLOYEE's work for COMPANY.
  - (b) That he will disclose promptly in writing to COMPANY's Patent Committee or to such person as COMPANY may designate, all inventions and improvements made or conceived by EMPLOYEE, either solely or in collaboration with others, during EMPLOYEE's employment by COMPANY whether or not during regular working hours, and relating to any methods, apparatus, products or components thereof, which, prior to the end of EMPLOYEE's employment, are manufactured, sold, leased, used or under development by or pertain to the business of the COMPANY.
  - (c) That he will, at the request and expense of COMPANY, make, execute, and deliver all application papers, assignments or instruments, and perform or cause to be performed such other lawful acts as COMPANY may deem desirable or necessary in making or prosecuting applications, domestic or foreign, for patents, re-issues, and extensions thereof, and assist and cooperate (without expense to him) with COMPANY or its representative in any controversy or legal proceedings relating to said inventions and improvements or to the patents which may be procured thereon. Should EMPLOYEE be requested after termination of his employment to perform services for COMPANY in connection hereunder, he shall be paid therefor at the same rate prevailing at the time of termination.
  - (d) That all said inventions and improvements made or conceived by EMPLOYEE, either solely or in collaboration with others, and whether or not patented, shall become and remain the property of COMPANY, its successors and

assigns unless expressly released by COMPANY as hereinafter provided.

- (e) That upon request or at the time of leaving the employ of COMPANY, he will deliver to COMPANY, and not keep or deliver to anyone else, any and all drawings, blueprints, notes, memoranda, specifications, devices, documents, and in general any and all material relating to COMPANY's business.
2. COMPANY will investigate each disclosure submitted by EMPLOYEE and agrees to pay all expenses in connection with the preparation and prosecution of such patent application or applications which it may decide to file in the United States of America or in foreign countries.
  3. If EMPLOYEE petitions COMPANY in writing to release any of its rights to any inventions or improvements which by this agreement are assigned to COMPANY, the latter will promptly consider and act on such petition but is not obligated to release any of its rights.
  4. EMPLOYEE warrants that the attached Exhibit A has been signed by him and comprises a complete description of all unpatented inventions and improvements which he made, invented, or conceived prior to entering the employ of COMPANY, to which he now claims title, and which are to be specifically excluded from this agreement. If no such exhibit is attached, no such unpatented inventions or improvements are excluded from the provisions of this agreement.
  5. Neither this agreement nor any benefits hereunder are assignable by EMPLOYEE, but the terms and provisions hereof shall inure to the benefit of COMPANY's successors and assigns.
  6. This agreement constitutes the entire agreement between COMPANY and EMPLOYEE with respect to the subject matter hereof save that it shall not in any way affect, supersede, or alter any previous agreements in which COMPANY has specifically released an invention or inventions to EMPLOYEE, and that this agreement shall become effective and binding retroactively to oldest date of employment including any subsidiary and/or division.

SANDOZ-WANDER, INC.

Date 8-10-70

By

J. H. Tregale  
DEPARTMENT HEAD

Sharon Cooper  
Witness

John D. Rothermel  
Employee

Jim Murray  
Witness